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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,791	03/30/2001	Donald R. Kaker	6995	3531

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EXAMINER

NAJARIAN, LENA

ART UNIT PAPER NUMBER

3626

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/820,791

**Applicant(s)**

KAKER ET AL.

**Examiner**

Lena Najarian

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20010330.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "76" has been used to designate both "search results page" and "launch report generator and populate report with data". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6 & 7 recite the limitation "the health care provider" in line 9 of claim 6 and line 2 of claim 7. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The statutory status of the instant claims under Section 101 will be analyzed with guidance from MPEP Section 2106.

(A) In the present case, claims 10-13 only recite an abstract idea. Exemplary claim 10 recites a "website." Claim 10 fails to define any structural or functional interrelationships between the website and other computer elements to permit the website's functionality to be realized.

For reasons given above, the claimed "website" appears merely to be a group of files, that is non-statutory functional descriptive material.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, claim 10 recites a useful and concrete (i.e. providing prescription assistance) but not tangible result for there is no provision to permit the website's functionality to be realized.

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(B) In the present case, claim 14 only recites an abstract idea. Claim 14 recites a “website.” Claim 14 fails to define any structural or functional interrelationships between the website and other computer elements to permit the website’s functionality to be realized.

For reasons given above, the claimed “website” appears merely to be a group of files, that is non-statutory functional descriptive material.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, claim 14 recites a useful and concrete (i.e. providing prescription assistance) but not tangible result for there is no provision to permit the website’s functionality to be realized.

(C) Moreover, in the present case, claims 15-19 only recite an abstract idea. Exemplary claim 15 recites “software.” Claim 15 fails to define any structural or functional interrelationships between the software and other computer elements to permit the software’s functionality to be realized.

For reasons given above, the “software” is non-statutory functional descriptive material.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, claim 15 recites a useful and concrete (i.e. tracking a patient’s prescription date) but not tangible result for there is no provision to permit the software’s functionality to be realized.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by IndiCare.

(A) Referring to claim 1, IndiCare discloses an online system for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers, comprising (page 5, para. 1 of IndiCare; the Examiner interprets “pharmaceutical companies” to be a form of “pharmaceutical manufacturers”):

- a) a web server connected to the internet (page 4, para. 2 of IndiCare);
- b) a database connected to said web server, said database including names of manufacturers of drugs providing prescription assistance to indigent patients and their respective application forms required to be filled out and submitted to the manufacturer to participate in the programs (page 3, para. 3 of IndiCare);
- c) at least one workstation connected to said web server through the internet (page 4 of IndiCare); and
- d) software operably associated with said web server and said database for searching the database for an application form by a user located at said at least one workstation by selecting manufacturer name or drug name, for viewing the forms on a monitor, for filling out the form for a patient and printing the form for sending to the manufacturer (page 3, para. 3 and page 5, para. 1 of IndiCare).

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(B) Referring to claim 2, IndiCare discloses wherein said software further includes means tracking the patient's renewal date for prescription (page 12, para. 6 of IndiCare).

(C) Referring to claims 3 and 4, IndiCare discloses wherein said software further includes means for manually filling out the form on the monitor and wherein said software further includes means for auto-filling the form (page 3, para. 3d of IndiCare; the Examiner interprets "not have to be reentered" to be a form of "auto-filling").

(D) Referring to claim 5, IndiCare discloses wherein said applications forms are stored in PDF files (page 4, para. 2g of IndiCare; the Examiner interprets "Adobe Acrobat Reader 3.01" as a system requirement to imply the use of "PDF files").

(E) Referring to claim 6, IndiCare discloses a method for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers, comprising (page 5, para. 1 of IndiCare):

- a) establishing a database including names of manufacturers of drugs providing prescription assistance to indigent patients and their respective application forms required to be filled out to participate in the programs (page 5, para. 2 of IndiCare);

- b) connecting the database online to a user;

- c) searching the database by the health care provider for an application form by selecting manufacturer name or drug name;

- d) viewing the form associated with selected manufacturer or drug on a monitor (page 3, para. 3 of IndiCare);

- e) filling out the form for a patient and printing the form for sending to the manufacturer (page 5, para. 1 of IndiCare).

(F) Referring to claim 7, IndiCare discloses tracking a date to remind the user to file a renewal application for the patient (page 12, para. 6 of IndiCare; the Examiner interprets "notification" to be a form of "remind" and "resubmission of the claim" to be a form of "renewal application").

(G) Referring to claims 8 & 9, IndiCare discloses wherein said filling the form is implemented by manually filling out the form on the monitor and wherein said filling out the form is implemented by means for auto-filling the form (page 3, para. 3d of IndiCare).

(H) Referring to claim 10, IndiCare discloses a website for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers, comprising (page 3, para. 1 of IndiCare):

- a) a login page for a user to register (Fig. 3 of IndiCare);
- b) a registered user's page displayed to the user when the user's login is accepted (page 7, para. 3 of IndiCare);
- c) a program forms page accessible from said registered user's page, said program forms page including a list of manufacturers and drugs to aid in finding a form required to be filled out and submitted to the manufacturer to participate in the programs (page 3, para. 3 of IndiCare); and
- d) a manual fill page accessible from said program forms page, said manual fill page displaying a selected manufacturer's blank form adapted to be filled out and printed for sending to the manufacturer (page 3, para. 3d and page 5, para. 2 of IndiCare).



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(I) Referring to claim 11, IndiCare discloses a) a tracking system entry page accessible from said registered user's page, said tracking system entry page for inputting patient information regarding prescription expiration date to calculate a renewal date for the patient (page 12, para. 6 of IndiCare; the Examiner interprets "Submission Prompting section" to be a form of "tracking system entry page").

(J) Referring to claims 12 & 13, IndiCare discloses wherein: a) said tracking system entry page further including means for generating reports showing activities for a specific patient and wherein: a) said tracking system entry page further including means for generating reports showing activities for a clinic (page 7, para. 2g of IndiCare).

(K) Referring to claim 14, IndiCare discloses a website for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers, comprising (page 3, para. 1 of IndiCare):

a) a login page for a user to register (Fig. 3 of IndiCare);

b) a registered user's page displayed to the user when the user's login is accepted (page 7, para. 3 of IndiCare);

c) a program forms page accessible from said registered user's page, said program forms page including a list of manufacturers and drugs to aid in finding a form required to be filled out and submitted to the manufacturer to participate in the programs (page 3, para. 3 of IndiCare); and

d) an autofill page accessible from said program forms page, said autofill page including means for filling out a selected application form and displaying the completed

form (page 3, para. 3d of IndiCare; the Examiner interprets “not have to be reentered” to be a form of “autofill”).

(L) Referring to claim 15, IndiCare discloses software for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers, comprising (page 3, para. 1 of IndiCare):

a) a database including names of pharmaceutical manufacturers providing programs for indigent patients, their respective drugs which they distribute and their respective forms required to be filled out to participate in the programs (page 3, para. 3 of IndiCare);

b) means for allowing online access by a user to the database (page 3, para. 3a and para. 3c); and

c) means for allowing a user to search online for a form by selecting manufacturer name or drug name, to view and fill out the form on a screen and to print the form (page 3, para. 3b and page 5, para. 2 of IndiCare).

(M) Referring to claim 16, IndiCare discloses a) means for tracking online by a user a patient's prescription renewal date (page 12, para. 6 of IndiCare).

(N) Referring to claim 17, IndiCare discloses a) means for generating a report online on patient activity (page 7, para. 2g of IndiCare).

(O) Referring to claims 18 & 19, IndiCare discloses means for manually filling out the form on the screen and means for autofilling the form (page 3, para. 3d of IndiCare).

### ***Conclusion***


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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches the place to learn about pharmaceutical manufacturer's drug assistance programs (<http://www.needymeds.com>); a compilation of application criteria and forms for use by health care providers applying for free pharmaceuticals for their qualified uninsured patients (<http://rxassist.org>); and medications – free or low cost meds (<http://www.usresolve.org/free-medications-and-prescriptions.php>).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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